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James F. McBride 43,784  
Name of Attorney/Agent Registration No.  
Signature of Attorney

IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
RESPONSE/AMENDMENT

Case Docket No. 8803

Mail Stop Non Fee Amendment  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is an AMENDMENT for the patent application:

Inventor(s): Rohrbaugh etal. Confirmation No. 9885

Serial No.: 10/020,064 Group Art Unit: 1755

Date Filed: December 13, 2003 Examiner: David M Brunzman

Title: COATINGS FOR MODIFYING HARD SURFACES AND PROCESSES FOR  
APPLYING SAME

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TC 1700

1. ☒ No additional fee is known to be required.
2. ☐ The fee has been calculated as shown below:

|   | (Col. 1)                                  |       | (Col. 2)                              | (Col. 3)          | OTHER THAN A<br>SMALL ENTITY |     |
|---|---|-------|---------------------------------------|-------------------|------------------------------|-----|
|   | CLAIMS<br>REMAINING<br>AFTER<br>AMENDMENT |       | HIGHEST NO.<br>PREVIOUSLY<br>PAID FOR | PRESENT<br>EXTRA* | RATE                         | FEE |
| TOTAL                                     | *   | MINUS | **                                    | =                 | x \$18 =                     | \$  |
| INDEP.                                    | *   | MINUS | ***                                   | =                 | x \$84 =                     | \$  |
| FIRST PRESENTATION OF MULTIPLE DEP. CLAIM |   |       |                                       |                   | + \$280 =                    | \$  |
|   |   |       |                                       |                   | TOTAL                        | \$  |

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the highest number of total claims previously paid for is less than 20, write "20" in this space.

\*\*\* If the highest number of independent claims previously paid for is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

3. ☐ The Commissioner is hereby petitioned under 37 CFR §1.136(a) to grant any extension of time needed for timely response to the Office Action dated in the above-identified application to preserve pendency of said application. The processing fee under 37 CFR §1.17 has been determined as follows: \$ for a -month extension of time.
4. The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 16-2480. A duplicate copy of this sheet is attached.
  - a. ☒ Any patent application processing fees under 37 CFR §1.16.
  - b. ☒ Any patent application processing fees under 37 CFR §1.17.
5. The Commissioner is hereby authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to Deposit Account No. 16-2480.

Date: October 3, 2003  
Customer No. 27752

(last revised 4/7/2003)

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Appl. No. 10/020,064  
Atty. Docket No. 8803  
Amdt. Dated October 3, 2003  
Reply to Office Action of September 9, 2003  
Customer No. 27752

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James F. McBride 43,784  
Name of Attorney/Agent Registration No.  
\_\_\_\_\_  
Signature of Attorney or Agent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

|                 |   |   |
|-----------------|---|---|
| Application No. | : | 10/020,064  |
| Applicant(s)    | : | Rohrbaugh et al.  |
| Filed           | : | December 13, 2001   |
| Title           | : | Coatings For Modifying Hard Surfaces And Processes For<br>Applying Same |
| TC/A.U.         | : | 1755  |
| Examiner        | : | David M. Brunzman   |
| Conf. No.       | : | 9885  |
| Docket No.      | : | 8803  |
| Customer No.    | : | 27752   |

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**RESPONSE AND ELECTION UNDER 37 CFR §1.143**

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**INTRODUCTORY REMARKS**

In response to the Restriction Requirement of September 9, 2003, the time for response being extended by (0) zero months, Applicants respectfully request withdraw of such requirement and offer the following remarks in support of such request.

### **REMARKS**

Claims 1-31 are pending. No claims are amended.

### **Restriction Requirement**

#### **I. Election With Traverse**

Applicants affirm the provisional election of Group I (Claims 1-12, 24 and 25) and their traversal of the restriction requirement.

#### **II. Basis For Traverse**

According to MPEP § 803, a restriction requirement between patentably distinct inventions is only proper when

- 1.) The inventions are independent or distinct; and
- 2.) There is a serious burden on the Examiner if restriction is not required.

A rebuttable prima facie showing of a serious burden can be made if the Examiner shows by appropriate explanation either separate classification, status in the art, or a different field of search as defined in MPEP § 808.02.

The Restriction Requirement contends that Groups I and II are distinct under MPEP § 806.05(f) and such Groups have acquired a separate status in the art as evidenced by their separate classifications.

Applicants respectfully contend that there is no undue burden as an art search for any of Groups I or II would be expected to yield the art that is pertinent to the patentability of each of Groups I and II. As a result of the foregoing, Applicants respectfully request that the present restriction requirement be withdrawn.

### **Election Of Species Requirement**

#### **I. Election Of Species With Traverse**

The September 9, 2003, Restriction Requirement requires Applicants to select a single disclosed species of nanoparticle for prosecution. As Applicants elected Group I for prosecution and the claims contained in such group recite smectite, hectorite and fluorohectorite, Applicants provisionally elect fluorohectorite for prosecution. Such election is made with traverse.

## II. Basis For Traverse

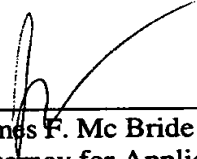
According to MPEP § 806.04(a) even if a restriction requirement is proper, an Applicant is entitled to claim a reasonable number of species. Applicants assert that a single species is less than a reasonable number. As a result, Applicants respectfully request that the examination be broadened to at least cover smectite, hectorite and fluorohectorite.

## Conclusion

Applicants respectfully request that the Examiner withdraw the restriction requirement and the election of species requirement. In the event there are remaining issues, the Examiner is invited to call Applicants' undersigned attorney to discuss such issues.

Respectfully submitted,  
Rohrbaugh et al.

By

  
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October 3, 2003  
Customer No. 27752  
(Amend.-Resp. to OA 09092003)